

REMARKS

By this amendment, claims 2 and 7 have been canceled without prejudice or disclaimer of the subject matter thereof, claims 1, 3, 4, 6, and 8-10 have been amended, and new claim 11 has been added. Claims 1, 3-6, and 8-11 are currently pending.

Claims 1, 5-6, and 8-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,513,551 to Morishita.¹ Claims 2-4 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morishita in view of U.S. Patent No. 6,433,991 to Deaton et al. ("Deaton").

Applicant wishes to thank the Examiner for taking the time to meet with Applicant's representative during the personal interview on February 14, 2005. The following remarks are consistent with the topics discussed.

A. Claim Rejections - 35 U.S.C. § 102(b)

Applicant respectfully traverses the rejection of claims 1, 5, 6, 8, and 9 under 35 U.S.C. § 102(b) for at least the reason that Morishita fails to disclose every claim element. For example, independent claim 1 recites, among other things, "said control device outputs a *sinusoid* signal to said directional fluid flow device to shift said directional control member to *dissipate energy* in the fluid." Further, independent claim 9 recites, among other things: "oscillating said directional control member to

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

dissipate energy in said swing cushion system in response to said signal.” Morishita fails to disclose at least these elements of claims 1 and 9.

Regarding claim 1, the Office Action has properly observed that Morishita fails to disclose the use of a sinusoidal signal. (See Office Action, page 4.) Accordingly, the 35 U.S.C. § 102(b) rejection of claim 1 and claims 5 and 6, which depend from claim 1, should be withdrawn.

Regarding claim 9, the Office Action describes Morishita as disclosing, in Figure 6, “oscillating said directional control member to dissipate energy in said swing cushion system in response to said signal.” However, Figure 6 does not disclose this element, nor does any other portion of Morishita. Figure 6 discloses varying flow rates through oil lines (28) and (29) to hydraulic cylinders (9) and (10) as the swing bracket (11) is *moved* between positions. (Morishita, paragraph bridging cols. 6 and 7.) Operating hydraulic cylinders simply to *move* a swing bracket between positions does not constitute “oscillating said directional control member *to dissipate energy* in said swing cushion system in response to said signal.”

In a separate passage, Morishita discloses how the swing bracket (11) is stopped by operating electromagnetic proportional control valve (19) in an opening direction for an *instant*. Morishita discloses that “[w]hen the swing bracket (11) is stopped at a position between the right and left limits . . . the electromagnetic proportional control valve (19) is operated back in an opening direction for an *instant* as the swing bracket (11) stops.” (See col. 7, lines 37-45, emphasis added.) Operating the control valve in an opening direction for an *instant* does not constitute “*oscillating* said directional control

member to dissipate energy in said swing cushion system in response to said signal,” as claimed. Accordingly, the 35 U.S.C. § 102(b) rejection of claim 9 and claim 8, which depends from claim 9, should be withdrawn.

B. Claim Rejections - 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 2-4 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Morishita in view of Deaton. No *prima facie* case of obviousness has been established with respect to claims 2-4 and 10 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

No *prima facie* case of obviousness has been established with respect to independent claims 1 and 10 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims. For example, independent claim 1, as amended, recites, among other things, “said

control device outputs a *sinusoid* signal to said directional fluid flow device to shift said directional control member to *dissipate energy* in the fluid.” Independent claim 10, as amended, recites similar elements, including, for example: “generating a signal . . . and *dissipating energy* in said swing cushion system using said signal, wherein generating said signal includes the steps of . . . producing a *sinusoid* signal indicative of said change rate.” Morishita and Deaton, taken alone or in combination, fail to teach or suggest at least these elements of claims 1 and 10.

The Office Action properly observed that Morishita does not teach or suggest the use of a sinusoidal signal (see Office Action, page 4). In an attempt to remedy this deficiency, the Office Action proposed combining the sinusoid signal in Deaton with the control signal in Morishita (see Office Action, page 4, citing Deaton at col. 4, lines 24-25). However, as discussed during the interview, the sinusoid signal of Deaton is used to move an operator member of a downhole device in incremental steps. (Deaton, col. 3, lines 12-22.) “The operating actuator is cycled between on and off states . . . to move an operator member of a downhole device in incremental steps” and the holding actuator is maintained in an active state to “latch or maintain the operator member in its current position after each move.” (Deaton, abstract, col. 3, lines 12-22.) The sinusoid signal of Deaton is not used to “shift said directional control member to *dissipate energy* in the fluid,” as recited in claim 1. Nor is the sinusoid signal of Deaton used to “[dissipate] energy in said swing cushion system,” as recited in claim 10.

Because Deaton fails to teach or suggest a sinusoid signal used to “shift said directional control member to *dissipate energy* in the fluid,” or to “[dissipate] energy in

said swing cushion system," as recited in claims 1 and 10, respectively, and because Morishita fails to even disclose the use of a sinusoid signal, no *prima facie* case of obviousness has been established with respect to claims 1 and 10.

Accordingly, the 35 U.S.C. § 103(a) rejection of claims 1 and 10, and claims 3 and 4, which depend from independent claim 1, should be withdrawn. New claim 11 depends from and adds additional features to independent claim 10 and is therefore also allowable for at least the reasons set forth above.

Conclusion

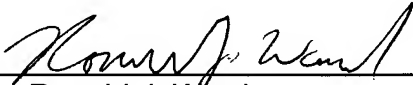
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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